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Technology Center 2100

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| In re Application of: Traversat, et al. |) |
| Application No. 10/055,773 |) DECISION ON PETITION FOR |
| Attorney Docket No. 5681-06800 |) SUPERVISORY REVIEW REGARDING |
| Filed: 1/22/2002 |) FINALITY OF RESTRICTION |
| For: PEER-TO-PEER COMPUTING |) REQUIREMENT UNDER 37 CFR |
| ARCHITECTURE |) §1.144 |

This is in response to the petition filed on June 16, 2006, under 37 CFR 1.144 requesting supervisory review of the finality of a restriction requirement made in the non-final Office action mailed on January 12, 2006. Note, A petition under 37 CFR §1.144 will not be considered if reconsideration of the requirement was not requested (see §1.181).

The petition is **GRANTED**.

RECENT PROSECUTION HISTORY

- (1) A restriction requirement was mailed on October 11, 2005, in which claims 1-116 were subject to restriction requirement.
- (2) On November 16, 2005 (certificate of mailing on November 14, 2005) a response to the restriction requirement was filed in which applicant provisionally elected with traverse. Applicant provided reasons in support of the traversal, including a discussion of M.P.E.P. §§ 806.05(c) and 808 regarding a proper restriction disclosed between combination and subcombination inventions.
- (3) On January 12, 2006, the Examiner issued a first office action on the merits, in response to Applicant's election, wherein claims 1-51, 77-96 & 101-113 were withdrawn. This office action determined the requirement for restriction to be proper and therefore made the requirement FINAL.
- (4) On April 17, 2006, an amendment and remarks were filed.
- (5) On June 16, 2006, the instant petition was filed by Petitioner, under 37 CFR §1.144.

RELIEF REQUESTED

The instant petition under 37 CFR 1.144 requests the following relief: withdrawal of the restriction requirement of October 11, 2005 (made final in the non-final Office action of January 12, 2006)

ANALYSIS

Petitioner provides arguments in support of the withdrawal of the election requirement including reference to M.P.E.P. § 808, which states:

Every requirement to restrict has **two aspects**: (A) the reasons (as distinguished from the mere statement of conclusion) why ****>**each invention< as claimed ***>**is< either independent or distinct **>**from the other(s)<; and (B) the reasons **>**why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons< for insisting upon restriction therebetween as set forth in the following sections.

In addition, as set forth in M.P.E.P. § 808.01:

****>**The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. For example, relative to a combination and a subcombination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not require the particulars of the subcombination as claimed. Each relationship of claimed inventions should be similarly treated and the reasons for the conclusions of distinctness or independence set forth. Form paragraphs 8.01, 8.02, and 8.14 - 8.20.02 may be used as appropriate to explain why the inventions as claimed are independent or distinct. See MPEP § 806.05 - § 806.06.<

And finally, M.P.E.P. § 806.05(a) sets forth:

A combination is an organization of which a subcombination or element is a part. The burden is on the examiner to suggest an example of separate utility. If applicant proves or provides an argument, supported by facts, that the utility suggested by the examiner cannot be accomplished, the burden shifts to the examiner to document a viable separate utility or withdraw the requirement.

The Office action of October 11, 2005 identifies two groups or sets of claims and their indicated classification i.e. Group I, claims 1-52, 77-96 & 101-113 (drawn to “computer-to-computer protocol implementing”) in class 709 subclass 230 and Group II, Claims 53-76, 97-100 & 114-116 (drawn to “distributed data processing”) in class 709 subclass 201. The Office action then identifies the claims of Group I and Group II as being related as combination and subcombination wherein, in the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because “it distinctly relates protocol implementing” and the subcombination has separate utility “such as distributed data processing.” Thus the Office action provides the reasons why each invention as claimed is deemed to be independent and distinct from the other, however, the Office action fails to provide the reasons why there would be a serious burden on the examiner if the restriction is not required. Form paragraphs 8.21.01 – 8.21.03 may be used as appropriate to explain why there would be a serious burden on the examiner if the restriction is not required.

In addition, consistent with Petitioner's remarks, at least some of the claims appear to be misidentified. Note, claim 36 (identified in Group I) and claim 53 (identified in Group II) both appear to be directed to similar inventions, i.e. a "single peer node" comprising "one or more network interfaces" and thus, do not appear to relate as *combination* and *subcombination*. In addition, claim 55, identified by the Examiner as a *subcombination* claim of Group II, is directed to a "peer computing system" comprising "a plurality of peer nodes". A system claim with an organization of parts or elements is generally representative of a combination-type claim (see M.P.E.P. § 806.05(a)).

Thus, and in accordance with M.P.E.P. §§ 806.05(a), 808 and 808.01, the election by original presentation restriction requirement of October 11, 2005, appears to misidentify claims into the two groupings and is incomplete, and therefore deemed to be improper.

The petition is **GRANTED**.

The application is being forwarded to the Technology Support Staff to **ENTER** the response filed April 17, 2006 and then **FORWARD** to the Examiner for appropriate action i.e. consideration of the amendment and claims consistent with this decision.

Any inquiries related to this decision may be directed to the undersigned at (571) 272-3595.



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